

**REMARKS**

**I. Status of the Claims**

Claims 36-74 are pending in this application. No claims have been amended.

**II. Rejections under 35 U.S.C. § 103**

**A. Mougin et al.**

Claims 36-42 and 44-74 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,945,095 ("Mougin et al."). *Office Action* at p. 2.

Applicants respectfully traverse this rejection.

Mougin teaches a cosmetic composition comprising "the use of a dispersion in a liquid fatty substance of surface-stabilized non-film-forming polymer particles." *Mougin* at col. 1, lines 58-61. Mougin does not disclose a colloidal dispersion comprising particles, as claimed. To counter Applicants' previous arguments, the Examiner maintains that it would have been obvious to add small particles of micrometer size to Mougin's composition because it "would be beneficial for a stable even dispersion in a system wherein surfactant present." *Office Action* at p. 2. The Examiner supports this statement on the rationale that "it is well known that, for a given amount of material, the surface area increases as the particle size is reduced." *Id.*

The Office has the initial burden to establish a *prima facie* case of obviousness. See, M.P.E.P. § 2143. To meet this burden, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify reference teachings with a reasonable expectation of success in obtaining the

claimed invention. See, M.P.E.P. § 2143.01; 2143.02. Moreover, "the prior art must suggest the desirability of the claimed invention." M.P.E.P. § 2143.01.

Applicants respectfully disagree that there is a suggestion to modify Mougín.

*Mougín* simply fails to provide any motivation for the claimed colloidal dispersion, and instead teaches that that its compositions achieve the desired effect without the use of the presently claimed colloidal dispersion. More specifically, *Mougín* recites "pulverulent compounds." Col. 9, lines 30-34. "Pulverulent" is defined as "made of, covered with, or crumbling to fine powder or dust." American Heritage Dictionary, 2<sup>nd</sup> ed., Houghton Mifflin Co., NY, 1991. "Colloid" is defined as a "suspension of finely divided particles in a continuous medium." *Id.* Based on these definitions, a pulverulent compound does not necessarily form a suspension in a continuous medium, as many fine powders can simply settle in the medium and not suspend. Thus, there is no basis in fact to equate a disclosure of "pulverulent compounds" with a colloidal dispersion, nor is there any teaching in Mougín that provides the requisite motivation to make any such modification.

The Examiner's rejection is premised on the fact that it is well-known to add small particles to create a "stable even dispersion." Mougín, however, explicitly teaches that its compositions are sufficiently stable on storage. *Mougín* at col. 2, lines 58-62 ("a composition may be obtained in the form of a compact powder which is stable on storage and has good cohesion, thereby making it possible to avoid easy crumbling of the compacted product."). Thus, there is no suggestion in Mougín of the desirability of adding the claimed colloidal dispersion for the additional reason that Mougín teaches that its compositions are already stable. One of ordinary skill in the art would not be

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motivated to improve the stability of Mougin's compositions without any suggestion to do so.

Furthermore, as disclosed in the present specification, the inventors have found that "above a small percentage of solid particles, these particles flocculate and aggregate or interact with the stabilizer of the polymer particles, thus rapidly destabilizing the compositions." Specification at p. 3. Such flocculation is minimized, if not eliminated, by virtue of, *inter alia*, the solid particles being in a colloidal dispersion. Neither a disclosure of a colloidal dispersion, nor the solution it provides, is mentioned anywhere in *Mougin*.

The only alleged motivation provided by the Examiner is a generalized statement that surface area increases as particle size is reduced, implying that the addition of smaller particles would improve the dispersability of the composition. Applicants respectfully submit that this general principle is not sufficient to establish a *prima facie* case of obviousness as this falls far short of providing the required motivation to modify *Mougin* in the manner suggested by the Examiner.

Accordingly, Applicants respectfully request withdrawal of this rejection.

**B. Mougin et al. and DE '062**

Claims 36-74 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,945,095 (Mougin et al.) and the abstract of DE 196 43 062 ("DE '062"). *Office Action* at p. 2. Applicants respectfully traverse this rejection.

Mougin is discussed above. The Abstract of DE '062 is cited for teaching that "pigment dispersions in an oil phase are stabilized with Applicant's preferred dispersants, poly-12-hydroxystearates for use in cosmetics." *See Non-Final Office*

*Action* at pp. 5-6. In the Final Office Action, the Examiner supports the combination of references by alleging that "one of ordinary skill would have been motivated to seek method for stabilizing the composition." *Final Office Action*. at p. 3.

Applicants respectfully disagree. As discussed above, Mougin explicitly teaches that its compositions are stable. Thus, there is no motivation to "seek method for stabilizing the composition," by any means as discussed above. Moreover, there is no suggestion that the method of DE '062 would improve the stability of Mougin's compositions. Evidence of a suggestion or motivation to modify or combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Without any specific suggestion to stabilize Mougin's already stable compositions, much less by the method of DE' 062, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. In addition, like *Mougin*, DE '062 fails to address the problem of flocculation of polymer particles during the direct introduction of the pigments, nacles, fillers, and mixtures thereof.

Accordingly, Applicants respectfully request withdrawal of this rejection.

### III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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If there is any fee due in connection with the filing of this Preliminary  
Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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